

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
H. TOYODA :
Serial No. 10/619,186 : Group: 3714
Filed: July 15, 2003 : Examiner: Pandya, Sunit
For: GAMING MACHINE, PROGRAM AND SERVER :
:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

May 9, 2008

Sir:

This Pre-Appeal Brief Request for Review is filed concurrently with a Notice of Appeal from the final Official Action dated December 13, 2007. The review is being requested for the reasons set forth below.

REMARKS

Claims 1-27 are pending in this application. Claims 1, 3, 17, 19, and 20 are independent.

INDEFINITENESS

In the final Official Action claims 13-16 stand rejected under 35 U.S.C. §112, second paragraph, as indefinite. In the Request for Reconsideration filed on March 11, 2008, the rejection was respectfully traversed.

However, the Advisory Action issued on April 23, 2008 does reassert (or even address) the rejection under 35 U.S.C. §112, second paragraph.

Accordingly, as understood, the §112, second paragraph, rejection is withdrawn.

However, to the extent the rejection is maintained, it is respectfully submitted that the rejection is improper for the reasons set forth on pages 1 and 2 of the above referenced Request for Reconsideration.

OBVIOUSNESS OVER THE PRIOR ART

Claims 1-27 stand rejected under 35 U.S.C. 103(a), as obvious over Barrie (US Patent 5,980,384).

Overview of One Certain Key Distinctions

Each of the independent claims (i.e. claims 1, 3, 17, 19, and 20) of the present application requires the capability to:

- (i) allocate symbols for a game to cells,
- (ii) shift the allocated symbols among the cells,
- (iii) after shifting, make cells with allocated symbols effective by lottery,
and
- (iv) make a disbursement if the cells made effective along a line have a winning combination of symbols.

As is discussed in detail in the materials referenced below, Barrie in fact lacks any disclosure making a cell effective after allocating a symbol to the cell. What Barrie teaches is a slot machine in which the applicable symbol is always effective. Even if Barrie could be reasonably construed to allocate symbols to cells (which it is respectfully submitted is not the case), the allocation of the symbol to the cell would necessarily make the cell effective.

Accordingly, Barrie necessarily fails to teach or suggest a disbursement based on the cells along a line having a winning combination of symbols and having been made effective by lottery after the shifting of symbols, as required by each of the independent claims.

Detailed Discussion of Recited Features and Limitations of Independent Claims 1, 3, 17, 19, and 20 that Distinguish Over Barrie

Please see the arguments presented in the Request for Reconsideration filed on March 11, 2008 (pages 2-9) and the Amendment filed on September 26, 2007 (pages 12-14).

Detailed Discussion of Exemplary Recited Features and Limitations of Certain Dependent Claims that Further Distinguish Over Barrie

Please see the arguments presented in the Request for Reconsideration filed on March 11, 2008 (pages 10-11).

The Advisory Action

In the Advisory Action dated April 23, 2008, in maintaining the final rejection of all claims, the Examiner asserts that "...it is noted that the features upon which applicant relies (i.e. loop of allocated symbols are shifted along the peripheral groups of cells) are not recited in the rejected claim(s)."

However, this feature is addressed in arguments relating to claims 1 and 3, and these claims explicitly recite the feature (see claim 1 and claim 3 as presented in the Amendment filed on December 17, 2007 (pages 1-2)).

The Examiner also asserts that "Barrie teaches of a gaming machine (slot machine), wherein symbols are allocated to each cell on a multi-cell gaming machine, wherein the symbol is selected randomly (col. 4: 29-43)... The game machine consists of a number generator that randomly places a symbol into each cell of the machine (col. 4: 29-43, col. 1: 29-35)."

However, the claims do not require that symbol allocated to each cell be a randomly selected symbol, but rather that cells with allocated symbols be made effective by lottery.

The Examiner further asserts that "Barrie also teaches of shifting symbols from original cell to an adjacent cell position (col. 4: 52-68)".

However, this fails to address the rebuttal arguments presented in the Request for Reconsideration relating to the fact that the shifting disclosed by Barrie is a shifting of symbols between two different games.

The Examiner additionally asserts that “Regarding the applicant's arguments that Barrie lacks any teaching or suggestion that discloses transformation should shift each symbol allocated to a cell within or belonging to a peripheral group of cells. The examiner disagrees with the applicant. As stated in the previous rejection Barrie, teaches of shifting each cell symbol to an adjacent cell within a peripheral group of cells (in col. 12: 36-55 as well as the other cited paragraphs in the rejection clearly teach of moving symbol from an original position to an end position and providing the players awards based on the bets made by the player).”

However, the newly cited reference to column 12, lines 36-55, of Barrie does not cure the defects in the asserted position as discussed in detail in the responses referenced above. Indeed, the newly cited text is a summary description related to the shifting of symbols from one game to another. Barrie itself acknowledges in this newly cited text that what is described is also described elsewhere in the specification disclosure in greater detail.

In view of the foregoing, it is respectfully submitted that the final Official Action fails to establish a *prima facie* basis for the asserted rejections, fails to establish that that prior art suggest the invention claimed in the present application, and can only be based on an improper hindsight reconstruction of the present invention based on subject applications own teachings.

It is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited.

To the extent necessary, Applicants hereby petition for an Extension of Time. Please charge any shortage in fees due in connection with the filing of this paper, including any extension of time fees, to the Deposit Account No. 01-2135 (Case No. 1227.42952X00) and please credit any excess fees to such Deposit Account.

Respectfully submitted,
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